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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,387	01/16/2002	Sam H. Chen	CHENS-11	8054

7590 10/08/2003  
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EXAMINER

SINGH, ARTI R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/047,387	Applicant(s) CHEN ET AL.	
	Examiner Ms. Arti Singh	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-26 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5772524 issued to Huang.

3. Huang discloses a water retarding golf club grip having an outer shock absorbing polyurethane layer, an intermediate water resistant layer, and an inner felt layer, such layers being bonded together to define an elongated resilient strip which is spirally wrapped about the grip-receiving portion of a golf club shaft by a double-sided adhesive watertight tape adhered to the underside of the felt layer with the side edges of the tape being bent upwardly over the sides of the strip to restrain entry of water into the felt layer (abstract). More particularly as shown in FIG. 5, elongated strip S includes a porous felt layer, generally designated 24, having an inner or bottom surface 26 which is adhered to the golf club shaft 20, by a conventional watertight double-sided adhesive tape T, an outer closed pore polyurethane layer 28 and a water retarding layer 30 integrally sandwiched between the outer polyurethane layer 28 and felt layer 24. Preferably, water retarding layer 30 is also formed of a polyurethane. The outer polyurethane layer 28 provides a shock absorbing cushioned grasp of the player's hand on golf club grip G, and also enhances the player's grip by providing increased tackiness between the player's hands and the grip. The felt layer 24 provides strength to the outer polyurethane layer and intermediate water resistant layer 30 serves as a means for attaching the bonded-together strip to golf club shaft 20, or to the

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sleeve 22 of FIG. 13. Water retarding polyurethane layer 30 restrains water from passing through the outer polyurethane layer 28 into the felt layer 24. The felt layer 24 has its upper surface 31 bonded to the lower surface of the water retarding polyurethane layer 30. The upper surface of the water retarding layer 30 is in turn bonded to the lower surface of the outer polyurethane layer 28. As indicated in FIG. 10, the outer polyurethane layer 28 is formed in a conventional manner (described in my above-referenced patents) with pores 36 which extend vertically, i.e. generally normal to the longitudinal axis of the strip S and golf club shaft 20 when the grip G has been affixed to such shaft. The water retarding polyurethane layer 30 is coated over the upper surface of the felt layer 24. The outer polyurethane layer 28 is formed over the water retarding polyurethane layer 30 in a conventional manner. Utilizing this method, there is formed the integral three layer strip S shown particularly in FIGS. 5 and 10. It has been found that satisfactory results can be obtained where the thickness of the felt layer 24 is between 0.4-3.0 millimeters, the thickness of the water resistant layer 30 is approximately 0.1 millimeter, and the thickness of the outer polyurethane layer 28 is approximately 0.1-1 millimeter. The thickness of the completed grip may be about 0.5-3.9 millimeters. Referring to FIG. 10, it should be noted that the provision of the pores 36 in the outer polyurethane layer 28 greatly increases the compressibility of the grip when grasped by a golfer. In this manner, increased shock absorbing characteristics are achieved, while the player is able to maintain a tight grasp of the grip to provide maximum control over the golf club. In this regard, applicant has discovered that greatly improved shock absorbing qualities may be obtained in a golf club grip where the ratio of the thickness of the polyurethane layer to the thickness of the felt layer is increased over the ratios employed in prior art grips. More specifically,

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applicant considers that the ratio of the thickness of the polyurethane layer to the textile layer should be a minimum of approximately 0.18 in order that pores 36 may be formed in the outer polyurethane layer. Excellent results have been obtained with this ratio, since the pores 36 permit the outer polyurethane layer to be readily compressed by the gripping force of a golfer's hands when making a swing. Referring to FIGS. 2 and 3, the tape T of FIG. 2 is trimmed along its butt and trailing edges to conform to the configuration of strip S. Tape T includes a felt body 40 coated on its first side with a watertight adhesive layer 42 and its second side by a second watertight adhesive layer 44. First adhesive layer is initially covered by a first peel-off removable protective paper 46, while second adhesive layer 44 is initially covered by a second peel-off removable protective paper 48. The upper or first side of the tape T is adhered to the underside of the felt layer 24 after the first protective paper 46 has been peeled off the first adhesive layer 42, as shown in FIG. 7. Thereafter, as indicated in FIG. 8, the side portions of the tape T will be bent upwardly over the sides of the strip S. Preferably, the side portions of the tape T will extend upwardly over felt layer 24 to approximately the mid-portion of the outer polyurethane layer 28. The outer polyurethane layer 28 is formed with a plurality of apertures such as perforations 50, which extend from the exterior surface of the outer polyurethane layer to the upper surface of the water retarding polyurethane layer 30. Such perforations enhance the absorption rate of perspiration from a user's hands.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29

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USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/045751 (Pub No. US 2003/0134088). Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/151084. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to be obvious variants of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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7. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6261191. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to obvious variants of one another.

8. Claims 1-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5851632. Although the conflicting claims are not identical, they are not patentably distinct from each other because they appear to obvious variants of one another.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Arti Singh whose telephone number is 703-305-0291. The examiner can normally be reached on M-F 9-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Ms. Arti Singh  
Patent Examiner  
Art Unit 1771

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